

REMARKS

Claims 1-9 and 12-19 will be pending upon entry of the present amendment. By way of the present amendment, claims 1 and 19 are amended, and claim 10 and 11 are cancelled. No new matter is being added. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Rejections Under 35 U.S.C. § 103

Claim 1, 2, 7-13 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,226,443 to Morioka et al. (hereinafter “Morioka”) in view of Applicants’ admitted prior art (hereinafter “AAPA”) described in the section entitled “Description of the Prior Art” in the specification of the instant application. Applicants traverse the rejections for at least the reasons discussed below.

Teaches Away

In Applicants prior Amendment, filed July 14, 2008, Applicants argued that AAPA taught away from the modification proposed in the previous Office Action. The instant Office Action states that the Examiner was not persuaded that AAPA taught way from the proposed modification because Applicants failed to argue the facts in cases cited by Applicants to the facts in the instant case.

The following cases were cited in Applicants prior Amendment: (1) *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994); (2) *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); (3) *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986); and (4) *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); and (5) *Honeywell International Inc. v The United States*, 81 Fed.Cl. 514, 560 (Fed.Cl., 2008).

Applicants cited *In re Gurley*, *supra*, *In re Grasselli*, *supra*, *In re Hedges*, *supra*, and *United States v. Adams*, *supra*, for at least the reason that they are cited in section 2145.D, entitled “Consideration of Applicant’s Rebuttal Arguments: References Teach Away from the Invention or Render Prior Art Unsatisfactory for Intended Purpose,” of MPEP, Eighth Edition, Revision 6. Applicants cited the aforementioned cases and cited the appropriate sections of the

MPEP to at the very least assist the Examiner in determining the USPTO's standard for "teaching away." Some of the facts of the aforementioned cases are provided in MPEP 2145.D, and consequently, Applicants incorporate them herein by reference.

Applicants cited *Honeywell International Inc. v The United States*, *supra*, to demonstrate, among other things, that post *KSR*, *supra*, courts still consider the "teaching away" argument for overcoming obviousness and for a standard for determining whether a reference teaches away, i.e., "A reference 'may be said to teachaway when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.'" *Honeywell International Inc. v The United States*, *supra*, quoting *In re Gurley*.

Prior Art That Merely **Discourages** One Off Ordinary Skill In The Art May Teach Away

Applicants respectfully submit that the Examiner has misinterpreted the legal standard for evaluating whether a reference "teaches away." A reference does NOT have to state that something cannot be done in order to "teach away." A reference "may be said to teachaway when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed.Cir.1994) (emphasis added). The principle pronounced by the Court in *In re Gurley*, *supra*, (a reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant) has been accepted and cited in numerous decisions by courts of law¹ and in numerous decisions by the Board of Patent Appeals and Interferences².

¹ See for example *Bayer Schering Pharma AG v. Barr Laboratories, Inc.*, WL 628592, 2008; *In re Icon Health And Fitness, Inc.*, 496 F.3d 1374, (Fed. Cir. 2007); *Optivus Technology, Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978 (Fed. Cir. 2006).

² See for example, *Ex parte Schneider et al.*, BPAI, Appeal 2008-3776 (Decided Feb. 17, 2009); *Ex parte Cesarini et al.*, BPAI, Appeal 2008-5792 (Decided Feb. 11, 2009); *Ex Merziger et al.*, BPAI, Appeal 2008-4919 (Decided Feb. 9, 2009).

AAPA Teaches Away

Applicants respectfully submit that Applicants' specification clearly teaches away from the proposed modification. For the sake of brevity, Applicants incorporate by reference Applicants prior Amendment, which discussed the teaching away of AAPA on page 10.

In addition, Applicants submit herewith a declaration from Richard W. Koralek, Ph.D. Dr. Koralek's expertise is discussed in the attached declaration, and in Dr. Koralek's opinion, AAPA discourages one of ordinary skill from Applicants' claimed methods.

Applicants' Claimed Methods Produce Surprising Result

AAPA discloses a shuffling function that shuffle bytes of audio data and discloses an inverse function to deshuffle may be non-linear. In particular, the shuffling function is a linear function of several parameters, e.g. (track number, sync block number, byte position in DIF block), that maps one-to-one the parameters to a particular index (n). However, the inverse of the shuffling function is a non-linear function of the index (n) that maps one-to-many, i.e., the index n is reverse mapped to multiple sets of the parameters used in the shuffling function. Due at least in part to the one-to-many mapping of the inverse function, it is surprising that a single DIF block may be deshuffled at one time.

Conclusion

Overall, the cited references do not singly, or in any motivated combination, teach or suggest the claimed features of the embodiments recited in independent claims 1, 12 and 19 and thus such claims are allowable. The remaining claims depend from allowable independent claims 1 and 12, and also include additional limitations; consequently, such claims are likewise allowable. If the undersigned attorney has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found.

In light of the above amendments and remarks, Applicants respectfully submit that all pending claims are allowable. Applicants, therefore, respectfully request that the Examiner reconsider this application and allow all pending claims. Examiner Khan is

encouraged to contact Mr. Ringer by telephone to discuss the above and any other distinctions between the claims and the applied references, if desired. If the Examiner notes any informalities in the claims, he is encouraged to contact Mr. Ringer by telephone to expediently correct such informalities. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
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Enclosure:
Declaration of Richard W. Koralek

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